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### REMARKS

Claims 1-5, 7, 8, 10-13, 15, 16 and 18 are pending. Claims 1-5, 7, 8, 10-13, 15, 16 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,032,612 to Williams ("Williams") in view of U.S. Patent No. 5,158,038 to Sheeks et al. ("Sheeks") and U.S. Patent No. 5,784,992 to Petite et al. ("Petite"). Applicant has amended independent Claim 1 to recite that only a single needle is positioned within the punch internal bore. Independent Claim 12 has been similarly amended. Applicant respectfully traverses the rejections under 35 U.S.C. §103 for at least the reasons set forth below.

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### §103 Rejections Are Overcome

Applicant respectfully submits that the combination of the primary reference, Williams, alone or in combination with the secondary references, Sheeks and Petite, fails to teach or suggest all of the recited elements of Applicant's amended independent Claims 1 and 12. Applicant's amended Claim 1 recites a method of introducing a substance into an avian egg, comprising:

- applying a sanitizing fluid to the shell of the egg to kill pathogens attached thereto;
  - forming an opening in the shell with a tubular punch, wherein the tubular punch has an internal bore, and wherein *only a single elongated needle is positioned within the internal bore*;
  - moving an elongated needle through the tubular punch internal bore and then through the opening and into an interior portion of the egg, wherein the needle comprises a hollow tube having a free end, *wherein the needle has a thickness that is smaller than 20 gauge, and wherein a cross-sectional area of the elongated needle is less than or equal to forty percent (40%) of a cross-sectional area of the internal bore of the tubular punch*;
  - releasing a substance into the egg via the needle;
  - retracting the needle from the egg; and
  - applying a sanitizing fluid to the needle to kill pathogens attached thereto.
- (Emphasis added).

The Final Action states that "Williams as modified does not explicitly teach that the cross-sectional area of the elongated needle is less than or equal to forty percent (40%) of a cross-sectional area of the internal bore of the tubular punch." (Final Action, Page 3). However, the Final Action states that "Williams inherently teaches this as illustrated in Williams Fig. 8, #290a" and "since there are three needles depicted in one bore of Williams #80, the cross sectional area element #290a (i.e. the elongated needle) inherently is less than 40% of the cross sectional area of element #80." (Final Action, Page 3).

Applicant respectfully submits that the inherency argument proposed by the Final Action fails the test for establishing inherency set forth by the Court of Appeals for the Federal Circuit. The Federal Circuit has set forth the Examiner's burden in establishing a *prima facie* case of inherency as a two-part test. *In re Robertson*, 169 F.3d 743; 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). Specifically, the Court stated:

If a particular prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is

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"inherent" in its disclosure. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

*In re Robertson*, 169 F.3d at 745, 49 U.S. P.Q.2d at 1950-51 (emphasis added, quotation and citations omitted).

The Final Action has failed to satisfy the two-part test because it has failed to present clear evidence that a person of ordinary skill would recognize, upon reading Williams, that the severity of pathogen carryover from one egg to the next can be reduced dramatically if the cross-sectional area of a needle is less than or equal to forty percent (40%) of the cross sectional area of the bore of a punch within which the needle is movably secured. Although it may be true that the cross-sectional area of one of the three illustrated needles in Fig. 8 of Williams is less than 40% of the cross-sectional area of the internal bore of punch 80, Williams fails to teach or suggest that such a ratio of cross-sectional areas decreases the severity of pathogen carryover. Moreover, the Final Action has failed to cite any passage in Williams that teaches or suggests reducing pathogen carryover.

Neither the primary reference Williams, nor the secondary references, teach or suggest that pathogen carryover by a needle operatively disposed within a tubular punch can be problematic. In addition to not recognizing the problem, there is no clear and particular evidence in the cited references that teaches or suggests the desirability of reducing needle size to affect/change the flow of sanitizing fluid around a needle within a punch for the purpose of addressing the problem of pathogen carryover. Nothing in the cited references would lead one skilled in the art to Applicant's claimed invention. The cited references do not contain the requisite motivation, suggestion or teaching of the desirability for requiring that a cross-sectional area of an elongated needle disposed within a tubular punch be less than or equal to forty percent (40%) of a cross-sectional area of the internal bore of the tubular punch.

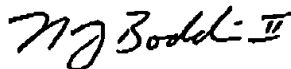
Accordingly, Applicant requests withdrawal of the present rejection of independent Claim 1 and all claims depending therefrom under 35 U.S.C. §103. For at least

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the reasons set forth above, Applicant respectfully submits that independent Claim 12 and all claims dependent therefrom are patentable. Accordingly, Applicant requests withdrawal of the present rejection of independent Claim 12 and all claims depending therefrom under 35 U.S.C. §103.

In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

Respectfully submitted,



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